

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-10 and 12-21. The Examiner also allowed claims 22-26. Applicants canceled claim 11 in a previous communication. Applicants thank the Examiner for the recognition of allowable subject matter in the present claims. By the present Response, Applicants amend claims 1, 13, and 14 to further clarify the claimed subject matter. Upon entry of the amendments, claims 1-10 and 12-26 will remain pending in the present patent application. Applicants respectfully request reconsideration of the above-referenced application in view of the foregoing amendments and the following remarks.

### **Amendments after Final Office Action**

Applicants submitted amendments to claims 1 and 13 after the Final Office Action mailed December 30, 2004. Particularly, as discussed in previous communications, these amendments stemmed from an interview between the Examiner and the undersigned representative on February 17, 2005. During the interview, the parties agreed upon certain amendments, which were ultimately submitted in the Response filed February 22, 2005, that overcame the prior art rejections based on the Hatch et al. reference. However, upon a new search, the Examiner discovered the newly cited Grzina reference and did not enter these after-final amendments. Accordingly, the present amendments include those amendments previously submitted after-final and, as the Examiner previously agreed, are believed to overcome the rejections that rely on the Hatch et al. reference. Applicants respectfully request entry of these amendments and withdrawal of the rejections based on the Hatch et al. reference.

### **Rejections Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-4, 7, 12-17, and 21 under 35 U.S.C. § 102(b) as anticipated by Grzina (U.S. Patent No. 4,895,460). Applicants respectfully traverse this rejection.

***Legal Precedent***

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

***Omitted Features of Independent Claims 1 and 13***

Turning now to the present claims, the Grzina reference fails to disclose each element of independent claims 1 and 13. For instance, independent claim 1 recites “a rotatable flinger secured to the cover ... and configured to form a *single-stage rotating seal*” (emphasis added). Similarly, independent claim 13 recites “a rotatable member securable to the cover ... [and] configured to form a *single-stage rotating seal*” (emphasis added). Because the Grzina reference fails to disclose such elements, the cited reference fails to anticipate independent claims 1 and 13.

The Grzina reference is directed to an improved seal for bearing assemblies. Col. 1, lines 4-5. The Grzina apparatus includes an end cover 6 secured to a bearing housing 9. Col. 1, lines 43-55. The bearing housing 9 is configured to receive a shaft 7 and bearings 8. *Id.* Further, a shaft collar is attached to shaft 7 and cooperates with seal rings 1A and 1B to form inner seal elements, while further cooperating with the cover 6 to form an outer seal element that is denoted labyrinth seal 3. Col. 2, lines 16-20. These seals control the egress of grease from the Grzina apparatus. Col. 2, lines 31-38. It is

important to note that the shaft collar of the cited reference forms both inner *and* outer seals. In other words, the shaft collar is configured to form a *multi-stage* seal assembly.

In the Office Action, the Examiner equates the shaft collar of the Grzina reference to the rotating flinger or member of the present claims. However, unlike the shaft collar of Grzina, independent claims 1 and 13, as amended, each clearly recite that the rotating flinger or member is configured to form a *single-stage* rotating seal. *See* FIG. 3. As the shaft collar taught by Grzina is clearly configured to form a multi-stage rotating seal, Applicants respectfully submit that this shaft collar cannot be reasonably considered to be a rotatable flinger or member “configured to form a single-stage rotating seal,” as recited by the instant claims. Further, the Grzina reference does not contain any other structure that can be reasonably equated with this recited element. Consequently, Applicants respectfully submit that the Grzina reference cannot support a *prima facie* case of obviousness with respect to independent claims 1 and 13. Accordingly, Applicants respectfully request withdrawal of the rejections based on the Grzina reference and allowance of independent claims 1 and 13, as well as the claims depending therefrom.

#### **Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1-4, 6, 7, and 12-17 under 35 U.S.C. § 103(a) as unpatentable over Hatch et al. (U.S. Patent No. 4,943,068) in view of Tripathy (U.S. Patent No. 6,149,158). The Examiner also rejected claim 6 as unpatentable over Grzina in view of Tripathy, claims 8 and 19-21 as unpatentable over Hatch et al. in view of Motsch, claims 9 and 10 as unpatentable over Grzina in view of Tooley, and claims 5 and 18 as unpatentable over Hatch et al. or Grzina in view of Uhen. As discussed above, the parties have agreed that the present amendments to claims 1 and 13 overcome the rejections based on the Hatch et al. reference. Accordingly, Applicants again respectfully request withdrawal of such rejections. Further, with respect to the rejections of claims 5, 6, 9, 10, and 18 that are based on the Grzina reference, Applicants respectfully traverse these rejections.

### ***Legal Precedent***

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

### ***Deficiencies of the Rejections***

Applicants note that each of claims 5, 6, 9, 10, and 18 depends from one of independent claims 1 or 13. As discussed above, the Grzina reference fails to disclose each element of independent claims 1 and 13. Further, the Tripathy, Tooley, and Uhen references do nothing to obviate the deficiencies of the Grzina reference. As a result, dependent claims 5, 6, 9, 10, and 18 are allowable on the basis of their dependency from a respective allowable independent claim, as well as for the subject matter recited in these dependent claims. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 5, 6, 9, 10, and 18.


For these reasons, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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